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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,536	08/08/2001	Ikuo Sakaguchi	Q65782	2109

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

LABAZE, EDWYN

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 05/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/923,536

Applicant(s)

SAKAGUCHI, IKUO

Examiner

EDWYN LABAZE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 3/7/2003.
2. Receipt is acknowledged of drawing corrections filed on 3/7/2003.
3. Claims 1-13, including newly added claims 11-13, are presented for examination.

#### *Priority*

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### *Drawings*

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation "a recorder" in claim 7 (page 6, line 7) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### *Claim Objections*

6. Claims 7-8 are objected to because of the following informalities:

9        Re claim 7 (page 6, line 7 of amendment 8): Substitute "said recorder" with "a recorder" and (line 8), substitute "said area" with "an area".

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-2, 7, and 11 are rejected under 35 U.S.C. 102(e) as being unpatented by Drexler (U.S. 6,199,761).

Re claims 1, 7 and 11: Drexler discloses validation method for electronic cash cards and digital identity cards utilizing optical data storage, which includes an identity card 11 in which a card identification code (a password also known as an identification code, which identifies the card holder) is registered (col.1, lines 60+; col.2, lines 36-67; col.3, lines 15+; col.5, lines 47+); a read unit/card reader 92 which reads the card identification code from the card (col.6, lines 29+); and a verification apparatus which verifies the card only when a place in which the read unit or card reader is located within a specific or geographical location/area corresponding to the card identification code (col.6, lines 1-67), further comprising a recorder, which the examiner broadly interprets as a storage unit incorporated in the verification unit and prohibiting or not permitting settlement when the place of the read unit does not belong/match to the area (col.5, lines 53+).

Re claim 2: Drexler teaches and apparatus and method, wherein the read unit/card reader 92 has a read unit identification code or password or validation data, and notifies the code to the verification apparatus (col.5, lines 56+); and the verification apparatus has a table/list or a database which shows a correspondence relation between the read unit identification code/password and the existing place/geographical area (col.6, lines 11+) and searches and acquires the existing place corresponding to the notified read unit identification code from the table (col.6, lines 1-20).

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3 -5, 9-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drexler (U.S. 6,199,761) in view of Seiderman (U.S. 5,388,148).

The teachings of Drexler have been discussed above.

Drexler fails to disclose a mobile phone, and storage unit, which stores data showing the area corresponding to the mobile phone, transmission over telecommunication network.

Seiderman disclose a cellular phone calling system using credit card validation, which includes a mobile phone 10 (col.19, lines 32+) and RAM 346 as a storage unit (col.19, lines 60+), means of transmitting over telecommunication network 36 (col.3, lines 1+; col.6, line 67).

In view of Seiderman' teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a mobile phone with storage unit

capability into the teaching of Drexler in order to manage the operation of the phone in specific area. Furthermore, such modification would enable the user access to the mobile phone only in predetermined geographical locations/areas concurrent to the area to which the phone belongs. Moreover, such modification would have been an obvious modification as taught by Drexler.

11. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drexler (U.S. 6,199,761).

The teachings of Drexler have been discussed above.

Drexler fails to teach a credit card.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a credit card into the system of Drexler so as to control the use of credit/debit card. Furthermore, such modification would be advantageous for both the card issuer by limiting the credit/debit card usage in predetermined locations/area in accordance with the place of the reader unit and to cardholder by guaranteeing the safety of the card being used in other locations/areas in case of a lost and/or theft. Moreover, such modification would have been an obvious extension of the teaching of Drexler, therefore an expedient.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Drexler (U.S. 6,199,761) in view of Seiderman (U.S. 5, 388,148).

The teachings of Drexler have been discussed above.

• Drexler fails to disclose means for deleting a recorded area.

Seiderman disclose a cellular phone calling system using credit card validation, which includes interface unit 16 with means for deleting (col.12, lines 64+).

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In view of Seiderman' teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate into the teaching of Drexler a mobile phone with means of deleting the recorded area/location if location/position of the mobile phone is not within the geographical area. Furthermore, such modification would permit the network to direct access/call/settlement to user only the recorded area within which the mobile phone belongs, manage the authentication/validation of the mobile phone, enhance the security of the mobile phone or credit card for accessing the phone and correlate the previously recorded data (such as geographical area/location issued with phone and/or card) with the current location as to access the phone/card. Moreover, such modification would have been an obvious extension of the teaching of Drexler.

#### *Response to Arguments*

13. Applicant's arguments filed on 3/7/2003 have been considered but moot in view of the new ground (s) of rejection.

#### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McAllister (U.S. 5,655,007) discloses telephone based credit card protection.

Cheng et al. (U.S. 5,502,759) teaches apparatus and accompanying methods for preventing toll fraud through use of centralized caller voice verification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
May 19, 2003  
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A handwritten signature in black ink, appearing to read 'Karl D. Frech', written in a cursive style.

KARL D. FRECH  
PRIMARY EXAMINER